



Docket No. 42982-C3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: S. Goldin et al.
SERIAL NO.: 09/637,512 EXAMINER: P. O'Sullivan
FILED: August 11, 2000 GROUP: 1621
FOR: THERAPEUTIC GUANIDINES

#11
4/9/03
J. M. Sullivan

THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, DC 20231

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RESPONSE TO OFFICE ACTION

Applicants are in receipt of the Office Action dated October 22, 2002. Applicants respond to that Office Action as follows.

Claims 25-27 and 29-31 were rejected under 35 U.S.C. 103 over Douglas (U.S. Patent 4,393,077). The rejection is traversed.

Applicant's claims recite guanidine compounds that include a guanidine moiety with *two* primary amino or unsubstituted imine (e.g. -NH_2 or =NH) groups.

The entire thrust of the Douglas document is to certain 1,3-disubstituted compounds, i.e. each of the amino nitrogens has at least one non-hydrogen substituent. See, for instance, Douglas at columns 7 through 10. Other named compounds of Douglas do not overlap with Applicants' claims.

The broad genus reported by Douglas also is not properly relied upon to substantiate the instant rejection. This is made clear e.g. by Section 2144.08 of the Manual of Patent Examining Procedure, which states in part:

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness.

* * *

Similarly, consider any teaching or suggestion in the reference of a preferred species or subgenus that is significantly different in structure from the claimed species or subgenus. Such a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness.

Reconsideration and withdrawal of the rejection are therefore requested.

Claims 25-27 and 29-31 were rejected under 35 U.S.C. 103 over Weber et al. (U.S. Patent 5,190,976) taken with Durant et al. (U.S. Patent 6,013,675) and Durant et al. (U.S. Patent 6,153,604). The rejection is traversed.

As discussed, the pending claims call for guanidine compounds that include a guanidine moiety with *two* primary amino or unsubstituted imine (e.g. -NH_2 or =NH) groups.

The cited documents do not disclose such compounds. The compounds named in the cited documents have one primary amino or unsubstituted imine group of a guanidine moiety.

Such structural differences make clear that a prima facie case under Section 103 does not exist here.

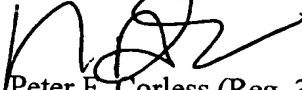
In view thereof, reconsideration and withdrawal of the rejection are requested.

In accordance with the Examiner's request, copies of the previously cited documents are being provided.

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It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter F. Corless', written over the typed name.

Peter F. Corless (Reg. 33,860)
EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, MA 02209
(617) 439-4444